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EXAMINER	
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ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/552,131	MELKOTE ET AL.	
	Examiner	Art Unit	
	Anh Ly	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to Applicants' AMENDMENT filed on 04/11/2006.

2. Claims 1-41 are pending in this Application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 17 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Based on a disclosure which is not enabling, "application filing process"; "prompting said plurality of inventors for invention disclosure approval"; and "performing a search to determining the state of the art associated with said invention disclosure and "at least partially directed by at least one inventor of said invention disclosure." critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the

description. (See § 1.58(a)). It is not clear how an application filing process is, how prompting for approval and to determine the state of the art. Applicants are advised to amend the claims 1, 17 and 34 to clarify how these are to be performed and their intended use. Applicants are reminded that no new matter should be added.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-2, 8-10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2001/0039505 A1 of Cronin (provisional application No.: 60/179,675, filed on Feb. 2, 2000).

With respect to claim 1, Takano teaches a method of forming an invention disclosure (using computer system over Internet for preparing patent specifications for patent applications: col. 1, lines 8-16) comprises the step of:

forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (a storage medium recording thereon a program for preparing patent specifications with inventors and persons in charge filing patent applications using a plurality of computer connected to a communication network, such as internet, for preparing patent specifications for patent applications: col. 1, lines 13-18 and col. 5, lines 55-61).

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (after the inventor prepared the draft data on a specification, the data is transmits to and stored the server computer 300 in order to allow the client computer 200 to download for revision and filing with the patent office: col. 6, lines 1-23); and

allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information (patent-application-filling person can download the draft for revision: col. 6, lines 5-19; preparing for patent application from inventors and persons in charge of filing patent applications by using a plurality of computers connected to a communication network such as Internet: col. 1, lines 10-20; and the inventor can download the revision to check before submitting to the Patent office: 13, lines 12-15).

Takano teaches a system and a method for preparing patent specifications for patent applications, allowing the users including inventors and co-inventors and persons in charge of filing patent specification to access the system for reviewing the information. Takano does not clearly teach allowing online access to the status of invention disclosure, said status comprising said invention disclosure is in a reviewing and application filing process.

However, Cronin teaches a web-based integrated software system and method for managing intellectual property (IP), invention review and application filing process components, tracking the status of invention disclosure (abstract, sections 0003, 0007, 0009, 0017-0018, 0040, 0044 and 0155).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Takano with the teachings of Cronin. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated tracking IP or invention disclosure system for keeping track of status of IP or invention disclosure, reviewing and filing a patent application (Cronin's abstract, and sections 0017-0018 and 0155), into the system of Takano for the purpose of managing IP, reviewing information and filing an patent application (section 0007), thereby, helping to facilitate tracking of IP prosecution based on a comprehensive tool (Cronin's section 0011).

With respect to claim 2, Takano teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in

response to the identification information (the inventor can access the upload file by login using password: col. 9, lines 59-61).

With respect to claim 8, Takano teaches comprising the step of notifying a patent staff in response to the classification information (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

With respect to claim 9, Takano teaches comprising the step of prompting a patentability review from the patent staff person (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

With respect to claim 10, Takano teaches wherein said central location comprises a database coupled to a web server (memory unit 310: col. 1, lines 48-49).

With respect to claim 12, Takano teaches wherein said step of notifying comprises the step of generating an E-mail having a hyperlink therein (col. 12, lines 8-28).

With respect to claim 14, Takano teaches comprising the step of providing a status update via E-mail (notification notify the draft have been upload for viewing by the patent-application-filing person or inventor: col. 12, lines 8-20).

With respect to claim 16, Takano teaches comprising the step of accepting a paper submission (convention system); and wherein the step of forming comprises scanning said paper submission into the database (conventional system: col. 1, lines 45-48).

8. Claims 3-4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2001/0039505 A1 of Cronin (provisional application No.: 60/179,675, filed on Feb. 2, 2000), and further in view of Patent No.: US 6,556,992 issued to Barney et al. (hereinafter Barney).

With respect to claim 3, Takano in view of Cronin discloses a method for identifying topics as discussed in claim 1.

Takano and Cronin disclose substantially the invention as claimed.

Takano and Cronin do not teach prompting the user for classification information.

However, Takano teaches prompting for the user for prior searching (col. 14, lines 9-17). On the other hand, Barney discloses prompting the user for classification information (col. 36, lines 41-44).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system to include classification information as taught by Barney in order patent application to arrive to the right patent staff for review. The motivation being for valuing or rating patents and other intellectual property (IP) assets (Barney's col. 1, lines 12-14 and col. 5, lines 34-38).

With respect to claim 4, Takano teaches a method as recited in claim 3 further comprising the steps of notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

With respect to claim 13, Takano in view of Cronin discloses a method for identifying topics as discussed in claim 1.

Takano and Cronin disclose substantially the invention as claimed.

Takano and Cronin do not teach comprises where said invention disclosure is in a patent office evaluation process.

However, Barney teaches the patent rating and evaluation process (col. 11, lines 10-20).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system to include classification information as taught by Barney in order patent application to arrive to the right patent staff for review. The motivation being for valuing or rating patents and other intellectual property (IP) assets (Barney's col. 1, lines 12-14 and col. 5, lines 34-38).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2001/0039505 A1 of Cronin (provisional application No.: 60/179,675, filed on Feb. 2, 2000), and further in view of Patent No.: US 6,556,992 issued to Barney et al. (hereinafter Barney) and Patent No.: US 6,185,689 issued to Todd, Sr. et al. (hereinafter Todd).

With respect to claim 5, Takano in view of Cronin and Barney discloses a method for identifying topics as discussed in claim 1.

Takano, Cronin and Barney disclose substantially the invention as claimed.

Takano, Cronin and Barney do not teach notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the E-mail.

However, Takano teaches notifying an evaluator comprising an E-mail (col. 12, lines 8-12). On the other hand, Todd discloses the hyperlink to the disclosure in the E-mail (col. 7, lines 61-65).

Therefore, it would have been obvious to one ordinary skill the art at the time of the invention was made to modify Takano, Cronin and Barney system to include hyperlink to link to the file in the e-mail as taught by Todd in order to provide the conveniences by accessing the file without requiring user name and password.

10. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2001/0039505 A1 of Cronin (provisional application No.: 60/179,675, filed on Feb. 2, 2000), and further in view of Patent No.: US 6,556,992 issued to Barney et al. (hereinafter Barney) and Patent No.: US 5,276,869 issued to Forrest et al. (hereinafter Forrest).

With respect to claim 6, Takano in view of Cronin and Barney discloses a method for identifying topics as discussed in claim 1.

Takano, Cronin and Barney disclose substantially the invention as claimed.

Takano, Cronin and Barney do not teach the step of prompting an evaluation comprises scheduling an evaluation meeting.

However, Forrest teaches scheduling an evaluation meeting (col. 9, lines 5-13).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano, Cronin and Barney's system to include scheduling a meeting include evaluation or voting as taught by Forrest in order to allow the inventor to explain their invention.

With respect to claim 7, Takano in view of Cronin and Barney discloses a method for identifying topics as discussed in claim 1.

Takano, Cronin and Barney disclose substantially the invention as claimed.

Takano, Cronin and Barney do not teach the step of prompting an evaluation comprises ranking the disclosure.

However, Forrest teaches evaluation ranking the disclosure (col. 8, lines 15-18).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano, Cronin and Barney's system to include weighting the disclosure of invention as taught by Forrest in order to determine if it is a good invention to submit into the patent office.

11. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2001/0039505 A1 of Cronin (provisional application No.: 60/179,675, filed on Feb. 2, 2000), and further in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter Balijepalli).

With respect to claim 11, Takano in view of Cronin discloses a method for identifying topics as discussed in claim 1.

Takano and Cronin disclose substantially the invention as claimed.

Takano and Cronin do not teach identifying co-authors; notifying co-authors of a disclosure with their name associated with therewith in the system.

However, Balijepalli discloses in fig. 5 with the template taking the user information including user name and password for accessing the system, and email addresses for notification system. This template is also used to registering inventor and co-inventor and their e-mail addresses for notification purposes.

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Cronin system to include Balijepalli system in order to notify both inventor and co-inventor as aught by Belijepalli in order to notify the applicants about the status of their application.

With respect to claim 15, Takano in view of Cronin discloses a method for identifying topics as discussed in claim 1.

Takano and Cronin disclose substantially the invention as claimed.

Takano and Cronin do not teach said server comprises a web single login.

However, Balijepalli discloses two fields to enter user name and password for accessing the server system (fig. 1).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Barney system to include user name and password to gain access to the server as taught by Balijepalli in order to provide authorize user to access the system.

12. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2002/0095368 A1of TRAN (provisional application No.: 60/185,644, filed on Feb. 29, 2000).

With respect to claim 17, Takano teaches an invention disclosure system (using computer system over Internet for preparing patent specifications for patent applications: col. 1, lines 8-16), comprising:

at least one user computer accessible by a plurality of inventors associated with a single invention disclosure; a server coupled to said at least one user computer; a database coupled to the server; and said server providing user screen to said least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, receiving the plurality of disclosure information from said users, storing information in said database after each of the plurality of disclosure information is entered, allowing access to said disclosure after storing the plurality of disclosure information within said database (the limitation of claim 17 is the same as of claim 1: a storage medium recording thereon a program for preparing patent specifications with inventors and persons in charge filing patent applications using a plurality of computer connected to a communication network, such as internet, for preparing patent specifications for patent applications) (col. 1, lines 13-18 and col. 5, lines 55-61; after the inventor prepared the draft data on a specification, the data is transmits to and stored the server computer 300 in order to allow the client computer 200 to download for revision and filing with the patent office: col. 6, lines 1-23; patent-application-filling

person can download the draft for revision: col. 6, lines 5-19; preparing for patent application from inventors and persons in charge of filing patent applications by using a plurality of computers connected to a communication network such as Internet: col. 1, lines 10-20; and the inventor can download the revision to check before submitting to the Patent office: 13, lines 12-15 and server computer, item 300, is storing the daft data or invention disclosure information: abstract).

Takano teaches a system and a method for preparing patent specifications for patent applications, allowing the users including inventors and co-inventors and persons in charge of filing patent specification to access the system for reviewing the information. Takano does not clearly teach prompting said plurality of inventors for invention disclosure approval.

However, Takano teaches prompting for the user for prior searching (col. 14, lines 9-17). On the other hand, TRAN teaches the invention disclosure being approved by all parties: inventors, co-inventor or IP professional or persons who supervised IP (sections 0040 –0041 and 0043).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Takano with the teachings of TRAN. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based online for approval of invention disclosure from all parties as disclosed (TRAN's sections 000040-0041), into the system of Takano for the purpose of managing IP, reviewing information and filing an patent application or trading IP (section

0001), thereby, helping to approve the IP with all parties over the web-based online invention disclosure system (section 0040).

With respect to claim 18, Takano teaches comprising a directory system coupled to said server whereby upon proving identification information to sever said server retrieves user information from the directory system in response to the identification information (the inventor can access the upload file by login using password: col. 9, lines 59-61).

With respect to claim 19, Takano teaches wherein said server comprises a web server (Internet: col. 1, lines 13-15).

With respect to claim 20, Takano teaches wherein said user computer comprises a web browser for accessing said server (access before downloading: col. 6, lines 5-15).

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2002/0095368 A1 of TRAN (provisional application No.: 60/185,644, filed on Feb. 29, 2000), and further in view of Pub. No.: US 2005/0125204 A1 of Garcia et al. (hereinafter Garcia).

With respect to claim 21, Takano in view of TRAN discloses an invention disclosure system as discussed in claim 17.

Takano and TRAN disclose substantially the invention as claimed.

Takano and TRAN do not teach comprises a computer aided design (CAD) file view coupled to said web browser.

However, Garcia draftpeople using CAD and CAD facility for viewer (sections 0030 and 0007, 0027).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and TRAN's system to include CAD facility for viewer as taught by Garcia in order patent application to arrive to the right patent staff for review. The motivation being for building the substation to interpret the drawings and in streamlining the deign drawings for patent application (Garcia's sections 0009-0010).

14. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Pub. No.: US 2002/0095368 A1 of TRAN (provisional application No.: 60/185,644, filed on Feb. 29, 2000), and further in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter Balijepalli).

With respect to claim 22, Takano in view of TRAN discloses an invention disclosure system as discussed in claim 17.

Takano and TRAN disclose substantially the invention as claimed.

Takano and TRAN do not teach said server comprises a web single login.

However, Balijepalli discloses two fields to enter user name and password for accessing the server system (fig. 1).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and TRAN's system to include user name and password to gain access to the server as taught by Balijepalli in order to provide authorize user to access the system.

15. Claims 23-24, 28-30, 33-34, 36 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Patent No.: US 6,339,767 issued to Rivette et al. (hereinafter Rivette).

With respect to claim 23, Takano teaches a method of forming an invention disclosure (using computer system over Internet for preparing patent specifications for patent applications: col. 1, lines 8-16) comprising:

forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (a storage medium recording thereon a program for preparing patent specifications with inventors and persons in charge filing patent applications using a plurality of computer connected to a communication network, such as internet, for preparing patent specifications for patent applications: col. 1, lines 13-18 and col. 5, lines 55-61).

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (after the inventor prepared the draft data on a specification, the data is transmits to and stored the server computer

300 in order to allow the client computer 200 to download for revision and filing with the patent office: col. 6, lines 1-23);

allowing access to various users for reviewing the information (patent-application-filling person can download the draft for revision: col. 6, lines 5-19; and the inventor can download the revision to check before submitting to the Patent office: 13, lines 12-15);

notifying an evaluator in response to the classification information (notifying the patent-application-filling persons: col. 12, line 9-13); and

prompting an evaluation from the evaluator (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

Takano teaches a system and a method for preparing patent specifications for patent applications, allowing the users including inventors and co-inventors and persons in charge of filing patent specification to access the system for reviewing the information. Takano does not clearly teach prompting the user for classification information, which refers to a technology area.

However, Takano teaches prompting for the user for prior searching (col. 14, lines 9-17). On the other hand, Rivette teaches classification information (col. 18, lines 55-67 and col. 60, lines 3-18) and area of technology (col. 93, 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Takano with the teachings of Rivette. One having ordinary skill in the art would have found it motivated to utilize

the use of a web-based online for classification information relating to area of technology as disclosed (Rivette's col. 93, lines 1-20), into the system of Takano for the purpose of managing IP, reviewing information and filing an patent application or trading IP (section 0001), thereby, helping to classify information related to technology area (col. 93, lines 1-20).

As to claim 24, Takano teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (col. 7, lines 64-67 and col. 8, lines 1-6).

With respect to claim 28, Takano teaches comprising the step of notifying a patent staff person in response to the classification information (the notification means 108 notifies, by electronic mail, notifying the patent-application-filing persons using the client computer 200: col. 12, lines 8-10).

With respect to claim 29, Takano teaches comprising the step of prompting a patentability review from the patent staff person (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

With respect to claim 30, Takano teaches wherein said central location comprises a database coupled to a web server (memory unit 310: col. 5, lines 48-49).

With respect to claim 33, Takano teaches comprising the step of viewing the status of the invention disclosure on-line (the inventor log-in to the server 300 to check if the applicant is done or need additional corrections: col. 9, lines 59-62).

With respect to claim 34, Takano teaches comprising the step of viewing the status of the invention disclosure update via E-mail (the inventor receive the email to review the revision of draft by e-mail) (col. 12, lines 8-13)

With respect to claim 36, Takano teaches comprising the step of accepting a paper submission (convention system); and wherein the step of forming comprises scanning said paper submission into the database (conventional system: col. 1, lines 45-48).

With respect to claim 37, Takano teaches a method of submitting documents comprising:

entering identification information into a user computer (the inventor enter password and user name from the user computer to gain access to the server 300) (col. 9, lines 59-63)

retrieving user information from a directory system in response to said identification information (the user can retrieve the name of the registered invention in the server) (col. 7, lines 64-67 and col. 8, lines 6);

entering disclosure information to creative an invention disclosure (the inventor can check the revision and make changes to the revision draft and submit to server 300) (col. 10, lines 8-15);

coupling said user information with said invention disclosure (each time the report containing inventor information and the draft are upload to the server 300) (col. 10, lines 15-30); and

storing the disclosure in a computer database (the draft copy of the invention is upload into the server 300) (col. 6, lines 1-4).

Takano teaches a system and a method for preparing patent specifications for patent applications, allowing the users including inventors and co-inventors and persons in charge of filing patent specification to access the system for reviewing the information. Takano does not clearly teach performing a search is at least the state of art associated with said invention disclosure and wherein said search is at least partially directed by at least one inventor of said invention disclosure.

However, Rivette teaches searching the prior art (fig. 40-44) and portion of patent (col. 2, lines 42-55 and col. 28, lines 1-14 and col. 54, lines 18-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Takano with the teachings of Rivette. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based online for classification information relating to area of technology as disclosed (Rivette's col. 93, lines 1-20), into the system of Takano for the purpose of managing IP, reviewing information and filing an patent application or trading IP (section 0001), thereby, helping to classify information related to technology area (col. 93, lines 1-20).

With respect to claim 38, Takano teaches a method as discussed in claim 37.

Takano teaches a system and a method for preparing patent specifications for patent applications, allowing the users including inventors and co-inventors and persons in charge of filing patent specification to access the system for reviewing the

information. Takano does not clearly teach prompting the user for classification information, which refers to a technology area.

However, Takano teaches prompting for the user for prior searching (col. 14, lines 9-17). On the other hand, Rivette teaches classification information (col. 18, lines 55-67 and col. 60, lines 3-18) and area of technology (col. 93, 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Takano with the teachings of Rivette. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based online for classification information relating to area of technology as disclosed (Rivette's col. 93, lines 1-20), into the system of Takano for the purpose of managing IP, reviewing information and filing an patent application or trading IP (section 0001), thereby, helping to classify information related to technology area (col. 93, lines 1-20).

With respect to claim 39, Takano teaches a method as recited in claim 3 further comprising the steps of notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious) (col. 15, lines 12-16).

With respect to claim 40, Takano teaches comprising the step of notifying a patent staff in response to the classification information (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

With respect to claim 41, Takano teaches comprising the step of prompting a patentability review from the patent staff person (the patent-application-filing person judge that the contents of the draft data are neither novel or unobvious: col. 15, lines 12-16).

16. Claims 25 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Patent No.: US 6,339,767 issued to Rivette et al. (hereinafter Rivette) and further in view of Patent No.: US 6,185,689 issued to Todd, Sr. et al. (hereinafter Todd).

With respect to claims 25 and 32, Takano in view of Rivette discloses a method for identifying topics as discussed in claim 23.

Takano and Rivette disclose substantially the invention as claimed.

Takano and Rivette do not teach notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the E-mail.

However, Takano teaches notifying an evaluator comprising an E-mail (col. 12, lines 8-12). On the other hand, Todd discloses the hyperlink to the disclosure in the E-mail (col. 7, lines 61-65).

Therefore, it would have been obvious to one ordinary skill the art at the time of the invention was made to modify Takano and Rivette' s system to include hyperlink to link to the file in the e-mail as taught by Todd in order to provide the conveniences by accessing the file without requiring user name and password.

17. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Patent No.: US 6,339,767 issued to Rivette et al. (hereinafter Rivette) and further in view of Patent No.: US 5,276,869 issued to Forrest et al. (hereinafter Forrest).

With respect to claim 26, Takano in view of Rivette discloses a method for identifying topics as discussed in claim 23.

Takano and Rivette disclose substantially the invention as claimed.

Takano and Rivette do not teach the step of prompting an evaluation comprises scheduling an evaluation meeting.

However, Forrest teaches scheduling an evaluation meeting (col. 9, lines 5-13).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Rivette's system to include scheduling a meeting include evaluation or voting as taught by Forrest in order to allow the inventor to explain their invention.

With respect to claim 27, Takano in view of Rivette discloses a method for identifying topics as discussed in claim 23.

Takano and Rivette disclose substantially the invention as claimed.

Takano and Rivette do not teach the step of prompting an evaluation comprises ranking the disclosure.

However, Forrest teaches evaluation ranking the disclosure (col. 8, lines 15-18).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Rivette's system to include weighting

the disclosure of invention as taught by Forrest in order to determine if it is a good invention to submit into the patent office.

18. Claims 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,434,580 issued to Takano et al. (hereinafter Takano) in view of Patent No.: US 6,339,767 issued to Rivette et al. (hereinafter Rivette) and further in view of Pub. No.: US 2004/0230566 A1 of Balijepalli et al. (hereinafter Balijepalli).

With respect to claim 31, Takano in view of Rivette discloses a method for identifying topics as discussed in claim 23.

Takano and Rivette disclose substantially the invention as claimed.

Takano and Rivette do not teach identifying co-authors; notifying co-authors of a disclosure with their name associated with therewith in the system.

However, Balijepalli discloses in fig. 5 with the template taking the user information including user name and password for accessing the system, and email addresses for notification system. This template is also used to registering inventor and co-inventor and their e-mail addresses for notification purposes.

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Rivette's system to include Balijepalli system in order to notify both inventor and co-inventor as aught by Belijepalli in order to notify the applicants about the status of their application.

With respect to claim 35, Takano in view of Rivette discloses a method for identifying topics as discussed in claim 23.

Takano and Rivette disclose substantially the invention as claimed.

Takano and Rivette do not teach said server comprises a web single login.

However, Balijepalli discloses two fields to enter user name and password for accessing the server system (fig. 1).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano and Rivette's system to include user name and password to gain access to the server as taught by Balijepalli in order to provide authorize user to access the system.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (**Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (Examiner's personal Fax No.**). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner: Jean Corrielus (571) 272-4032**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

Central Fax Center: (571) 273-8300

ANH LY
JUN. 12th, 2006

JEAN M. CORRIELUS
PRIMARY EXAMINER